

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
	)	
Edward L. Beery II	)	Group Art Unit: 1751
	)	
Serial No.: 09/954,823	)	Examiner: Nguyen, Tri V.
	)	
Filing Date: September 18, 2001	)	Confirmation No.: 8192
	)	
For: System for Delivery of Promotional Savings	)	

**REPLY BRIEF**

To: Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed May 8, 2007.

## ARGUMENT

### I. Rejections Under 35 U.S.C. §102

Claims 9-23, 25, 26, and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,055,513 to Katz, et al (hereinafter, “Katz”). These rejections must be reversed because the Examiner has failed to establish that Katz anticipates the pending claims.

Both the grounds of rejection and the text cited to support the rejections in the Examiner’s Answer appear to be identical to the grounds of rejection and the text cited in the final Office Action mail July 18, 2006. The only substantive changes to the Examiner’s arguments begin on page 7 of the Examiner’s answer, under the heading “Examiner’s Response.” Therefore, this reply brief will focus on the arguments proffered by the Examiner in the Examiner’s Response section.

Initially, Appellant noticeably Examiner’s answer remains deficient for at least the following reasons. First, the Examiner appears to misunderstand which party bears the burden of proof with respect to establishing a *prima facie* case of anticipation. As noted in the Appeal Brief, “It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.” *Ex parte Skinner*, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. Int. 1986) (holding that examiner failed to establish *prima facie* case of anticipation). Only if that burden is met, does the burden of going forward shift to the Appellant.

In this case, the rejections in the final Office Action failed to establish with any degree of particularity the manner in which Katz discloses the elements of the pending claims. Therefore, the rejections in the final office action failed to establish a *prima facie*

case of anticipation. The Appeal Brief set forth in clear and concise terms the deficiencies in the final action, and invited the Examiner to point out with particularity the sections of Katz which allegedly disclose the elements of the pending claims. The Examiner's Answer makes no attempt to point out specifically which sections of Katz allegedly disclose the elements of the pending claims. Instead, the Examiner's Answer simply cites broad sections of Katz and asserts that the sections must disclose the pending claims. There is absolutely no evidence of record which maps the disclosure of Katz onto the pending claims.

Further, the arguments proffered in the Examiner's Answer are completely irrelevant because they are wholly unrelated to the language of the claims. The Examiner argues repeatedly that Katz anticipates the pending claims because Katz discloses triggering an upsell based on data elements associated with a primary transaction/interaction. Even assuming, *arguendo*, that the Examiner is correct, Katz still cannot anticipate the pending claims because the pending claims recite structure and operations far more specific than simply triggering an upsell based on data elements associated with a primary transaction/interaction.

In the interest of brevity, many arguments and excerpts from Katz set forth in the Appeal Brief will not be repeated in this document. Nonetheless, these arguments are incorporated herein.

#### A. Legal Standard for Anticipation

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of *strict identity*. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidation for anticipation requires that all of the elements and limitations of the

claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (finding that the jury had been erroneously instructed that anticipation may be shown by equivalents, a legal theory that is pertinent to obviousness under Section 103, not to anticipation under Section 102). “The identical invention must be shown in as complete detail as is contained in the patent claim.” MPEP §2131 (7<sup>th</sup> Ed. 1998) (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Furthermore, functional language, preambles, and language in “whereby,” “thereby,” and “adapted to” clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

“It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office.” *Ex parte Skinner*, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. Int. 1986) (holding that examiner failed to establish *prima facie* case of anticipation). The examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the Appellant.

B. Claims 9 and 17

Neither the final Action nor the Examiner’s Answer establish a *prima facie* case that Katz anticipates claim 9. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has “the burden of proof. . . to produce the factual basis

for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 9 is directed to a method for presenting one or more promotions and recites a limitations directed to:

receiving, in a computing system, a signal identifying a first product associated with an order;  
associating a first product identifier with the first product;  
presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier.

As the Appeal Brief makes clear, the cited sections from Katz fails to disclose any of the elements recited in claim 9. First, contrary to the Examiner’s assertion, nothing in the text cited from Katz discloses (or even suggests) receiving, in a computing system, a signal identifying a first product associated with an order. In fact, the cited text from Katz is wholly silent with respect to the manner in which a user identifies a product. Further, contrary to the Examiner’s assertion, nothing in the text cited from Katz discloses (or even suggests) associating a first product identifier with the first product. A close review of column 24, lines 31-49 reveals that the text fails even to mention products or product identifiers, much less the specific step of associating a first product identifier with the first product. Finally, nothing in the cited text discloses (or even suggests) presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier. A close examination of column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55, and column 26, line 66 to column 27, line 21 reveals that Katz discloses offering an upsell based on a number of factors, none of which correspond to offering a promotion for a second product when the second product is associated with the first product identifier.

In the event the Examiner wishes to maintain the rejection, Appellant again invites

the examiner to point out with particularity what portions of the cited text are alleged to correspond to presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier, as recited in the claim. In the absence of a showing that particular sections about Katz disclose the elements of the claim, there remains no evidence whatsoever on the record to support a rejection under 35 U.S.C. §102.

In the Examiner's Response section of the Examiner's Answer, the Examiner asserts that Katz anticipates claim 9 because Katz discloses a telemarketing method that is implemented in a computer network system in which a primary transaction/interaction triggers and up selling opportunity that is based on data elements associated with the primary transaction/interaction. The Examiner further asserts that the Katz reference defines the term upsell as an offer or provision of a good or service which is selected for offer to the customer and it differs from the good or service for which the primary contact was made. The term upsell is not limited to the context in which a primary transaction is intended to be a sales transaction, but additionally includes the offer of a good or service offered in accordance with the selection criteria of the invention even if the primary transaction is not principally sales motivated, such as where an initial contact is for service or repair purposes. The various upsells (i.e., a product or service related to the primary transaction) are presented to the user via the computer interface.

Appellant expresses no opinion on the accuracy of the Examiner's characterization of the Katz reference. However, the Examiner's characterization of the Katz reference is wholly unrelated to the language of the limitations recited in claim 9. Therefore, even if the Examiner's characterization is accurate, Katz still cannot anticipate claim 9.

In sum, neither the final Action nor the Examiner's answer has established the factual

evidence necessary to establish a *prima facie* case of anticipation of claim 9. Furthermore, Katz fails to disclose or suggest elements of claim 9, and therefore cannot anticipate claim 9. Therefore, the rejection of claim nine under 35 U.S.C. §102(b) must be reversed.

Claim 17 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 17.

C. Claims 10 and 18

Neither the final Action nor the Examiner's Answer establish a *prima facie* case that Katz anticipates claim 10. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 10 recites limitations including "determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier." The final Action asserted that Katz discloses this limitation, and cited column 23, line 62 to column 25, line 55 to support the rejection. Appellant traversed the rejection. The Examiner's Answer maintains the rejection and now cites column 22, lines 31-45 and column 24, lines 31-49 to support the rejection. The newly cited text reads as follows:

The final aspect of the primary transaction is the completion or consummation of the primary transaction. In one implementation, the primary transaction may be completed, such as through consummation of a sale or completion of a service call or request. In yet other aspects, the primary transaction may be concluded, though not with the provision of the originally contemplated good or service. For example, in the context of a service contact, if the upsell is successful in providing the user with a replacement product, the primary transaction need not be completed. Optionally, at the caller's discretion, the primary transaction could be completed, such as where a caller does purchase a replacement product, but yet still wishes to obtain service on the product which form the basis for the original contact, and for the upsell.

Other factors affecting the upsell may include inputs comprising areas of interest, such as based upon known subscriptions, prior contact of the user to other sites, such as other Internet sites may be utilized by the system to determine a user's possible interests, and therefore, their susceptibility to the upsell of particular goods or services. Yet another aspect of basing the upsell selection on prior purchases may include upgrades to prior purchases. For example, where the system determines that the user has previously purchased a computer of a given make and model, the system may offer as an upsell a good or service particularly adapted to improve the performance of the system of the user, such as provision of additional memory, or other modified component. Similarly, if a user is known to have a given version of software, the system may elect to offer a new version of the software. Obsolescence of prior purchases may be determined. This may be from the passage of time, updating of a product, or outgrowing of a prior purchase.

Initially, Appellant notes that neither the final Action nor the Examiner's Answer point out with any particularity the manner in which the cited text discloses or suggests determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier, as recited in claim 10. Further, a close examination of the text cited in the Examiner's answer reveals that Katz discloses offering an upsell based on a number of factors, none of which correspond to determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier.

In the event the Examiner wishes to maintain the rejection, Appellant again invites the examiner to point out with particularity what portions of the cited text are alleged to correspond to presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier, as recited in the claim. In the absence of a showing that particular sections about Katz disclose the elements of the claim, there remains no evidence whatsoever on the record to support a rejection under 35 U.S.C. §102.

In the Examiner's Response section of the Examiner's Answer, the Examiner asserts that Katz anticipates claim 10 because Katz discloses a telemarketing method that is



implemented in a computer network system in which a primary transaction/interaction triggers and up selling opportunity that is based on data elements associated with the primary transaction/interaction. Again, Appellant expresses no opinion on the accuracy of the Examiner's characterization of the Katz reference. However, the Examiner's characterization of the Katz reference is wholly unrelated to the language of the limitations recited in claim 10. Therefore, even if the Examiner's characterization is accurate, Katz still cannot anticipate claim 10.

In sum, neither the final Action nor the Examiner's answer has established the factual evidence necessary to establish a *prima facie* case of anticipation of claim 10. Furthermore, Katz fails to disclose or suggest elements of claim 10, and therefore cannot anticipate claim 10. Therefore, the rejection of claim nine under 35 U.S.C. 102(b) must be reversed.

Claim 18 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 18.

D. Claims 11 and 19

Neither the final Action nor the Examiner's Answer establish a *prima facie* case that Katz anticipates claim 11. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 11 recites limitations including "comparing the first product identifier with a list of product identifiers associated with promotional offers." The final Action asserted that Katz discloses this limitation, and cited column 23, line 62 to column 25, line 55 to support the rejection. Appellant traversed the rejection, and invited the Examiner to point out with

specificity. The Examiner's Answer maintains the rejection and now cites the same text to support the rejection.

Initially, Appellant notes that neither the final Action nor the Examiner's Answer point out with any particularity the manner in which the cited text discloses or suggests comparing the first product identifier with a list of product identifiers associated with promotional offers, as recited in claim 11. Further, a close examination of the text cited in the Examiner's answer reveals that Katz discloses offering an upsell based on a number of factors, none of which involve comparing the first product identifier with a list of product identifiers associated with promotional offers.

In the event the Examiner wishes to maintain the rejection, Appellant again invites the examiner to point out with particularity what portions of the cited text are alleged to correspond to presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier, as recited in the claim. In the absence of a showing that particular sections about Katz disclose the elements of the claim, there remains no evidence whatsoever on the record to support a rejection under 35 U.S.C. §102.

In the Examiner's Response section of the Examiner's Answer, the Examiner asserts that Katz anticipates claim 11 because Katz discloses a telemarketing method in which the upsell is determined by inputs associated with the primary transaction/interaction and the various upsell items are offered to the customer. Again, Appellant expresses no opinion on the accuracy of the Examiner's characterization of the Katz reference. However, the Examiner's characterization of the Katz reference is wholly unrelated to the language of the limitations recited in claim 11. Therefore, even if the Examiner's characterization is accurate, Katz still cannot anticipate claim 11.

In sum, neither the final Action nor the Examiner's answer has established the factual evidence necessary to establish a *prima facie* case of anticipation of claim 11. Furthermore, Katz fails to disclose or suggest elements of claim 10, and therefore cannot anticipate claim 11. Therefore, the rejection of claim nine under 35 U.S.C. 102(b) must be reversed.

Claim 19 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 19.

E. Claim 12

Neither the final Action nor the Examiner's Answer establish a *prima facie* case that Katz anticipates claim 12. Anticipation under 35 U.S.C. § 102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 12 recites limitations including "wherein a promotion is associated with a combination of one or more product identifiers." The final Action asserted that Katz discloses this limitation, and cited column 23, line 62 to column 25, line 55 to support the rejection. Appellant traversed the rejection, and invited the Examiner to point out with specificity. The Examiner's Answer maintains the rejection and now cites the same text to support the rejection.

Initially, Appellant notes that neither the final Action nor the Examiner's Answer point out with any particularity the manner in which the cited text discloses or suggests wherein a promotion is associated with a combination of one or more product identifiers, as recited in claim 12. Further, a close examination of the text cited in the Examiner's answer reveals that Katz discloses offering an upsell based on a number of factors, none of which involve wherein a promotion is associated with a combination of one or more product

identifiers.

In the event the Examiner wishes to maintain the rejection, Appellant again invites the examiner to point out with particularity what portions of the cited text are alleged to correspond to wherein a promotion is associated with a combination of one or more product identifiers, as recited in the claim. In the absence of a showing that particular sections about Katz disclose the elements of the claim, there remains no evidence whatsoever on the record to support a rejection under 35 U.S.C. §102.

In the Examiner's Response section of the Examiner's Answer, the Examiner asserts that Katz anticipates claim 12 because Katz discloses a telemarketing method in which the upsell is an offer of a good or a service or to a coupon, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or service.. Again, Appellant expresses no opinion on the accuracy of the Examiner's characterization of the Katz reference. However, the Examiner's characterization of the Katz reference is wholly unrelated to the language of the limitations recited in claim 12. Therefore, even if the Examiner's characterization is accurate, Katz still cannot anticipate claim 12.

In sum, neither the final Action nor the Examiner's answer has established the factual evidence necessary to establish a *prima facie* case of anticipation of claim 12. Furthermore, Katz fails to disclose or suggest elements of claim 10, and therefore cannot anticipate claim 12. Therefore, the rejection of claim nine under 35 U.S.C. 102(b) must be reversed.

F. Claims 13 and 20

Neither the final Action nor the Examiner's Answer establish a *prima facie* case that Katz anticipates claim 13. Anticipation under 35 U.S.C. §102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See,

MPEP 2131). Moreover, the Examiner has “the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103.” *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 13 recites limitations including “presenting one or more replacement products in the user interface.” The final Action asserted that Katz discloses this limitation, and cited column 23, line 62 to column 25, line 55 to support the rejection. Appellant traversed the rejection, and invited the Examiner to point out with specificity. The Examiner’s Answer maintains the rejection and now cites the same text to support the rejection.

Initially, Appellant notes that neither the final Action nor the Examiner’s Answer point out with any particularity the manner in which the cited text discloses or suggests presenting one or more replacement products in the user interface, as recited in claim 13. Further, a close examination of the text cited in the Examiner’s answer reveals that Katz discloses offering an upsell based on a number of factors, but that none of which involve presenting one or more replacement products in the user interface.

In the event the Examiner wishes to maintain the rejection, Appellant again invites the examiner to point out with particularity what portions of the cited text are alleged to correspond to presenting one or more replacement products in the user interface, as recited in the claim. In the absence of a showing that particular sections about Katz disclose the elements of the claim, there remains no evidence whatsoever on the record to support a rejection under 35 U.S.C. §102.

In the Examiner’s Response section of the Examiner’s Answer, the Examiner asserts that Katz anticipates claim 13 because Katz discloses the future of offering replacement products in the upsell telemarketing method. Again, Appellant expresses no opinion on the accuracy of the Examiner’s characterization of the Katz reference. However,

the Examiner's characterization of the Katz reference is wholly unrelated to the language of the limitations recited in claim 13. Therefore, even if the Examiner's characterization is accurate, Katz still cannot anticipate claim 13.

In sum, neither the final Action nor the Examiner's answer has established the factual evidence necessary to establish a *prima facie* case of anticipation of claim 13. Furthermore, Katz fails to disclose or suggest elements of claim 13, and therefore cannot anticipate claim 13. Therefore, the rejection of claim nine under 35 U.S.C. 102(b) must be reversed.

Claim 20 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 20.

G. Claims 23 and 26

Neither the final Action nor the Examiner's Answer establish a *prima facie* case that Katz anticipates claim 23. Anticipation under 35 U.S.C. § 102 requires that *each and every element* of the claim be set forth in the manner recited in the claim in a single prior art reference. (See, MPEP 2131). Moreover, the Examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Claim 23 is directed to a computer-based method of delivering a promotional offer to a consumer and recites a limitations directed to:

storing criteria for a promotional offer in a computer-readable memory;  
receiving, in a computing system, a signal identifying a first product  
associated with a consumer order;  
comparing a first product identifier associated with the first product with  
the criteria for a promotional offer; and  
presenting a promotional offer in a user interface when the first product  
identifier corresponds to a criteria for a promotional offer.

As the Appeal Brief makes clear, the cited sections from Katz fails to disclose any of the elements recited in claim 9. First, contrary to the Examiner's assertion, nothing in the text cited from Katz discloses (or even suggests) storing criteria for a promotional offer in a computer-readable memory or receiving, in a computing system, a signal identifying a first product associated with a consumer order. Further, contrary to the Examiner's assertion, nothing in the text cited from Katz discloses (or even suggests) comparing a first product identifier associated with the first product with the criteria for a promotional offer. A close review of column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55 and column 26, line 66 to column 27, line 21 reveals that the text fails even to mention products or product identifiers, much less the specific step of comparing a first product identifier associated with the first product with the criteria for a promotional

offer. Finally, nothing in the cited text discloses (or even suggests) presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer. A close examination of column 13, lines 27-51, column 17, line 37 to column 18, line 15, column 23, line 62 to column 25, line 55, and column 26, line 66 to column 27, line 21 reveals that Katz discloses offering an upsell based on a number of factors, none of which correspond to presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer.

In the event the Examiner wishes to maintain the rejection, Appellant again invites the examiner to point out with particularity what portions of the cited text are alleged to correspond to presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier, as recited in the claim. In the absence of a showing that particular sections about Katz disclose the elements of the claim, there remains no evidence whatsoever on the record to support a rejection under 35 U.S.C. §102.

In the Examiner's Response section of the Examiner's Answer, the Examiner asserts that Katz anticipates claim 23 because Katz discloses a telemarketing method that is implemented in a computer network system in which a primary transaction/interaction triggers and up selling opportunity that is based on previously stored data elements associated with the primary transaction/interaction. The various upsells (i.e., a product or service related to the primary transaction) are presented to the user via the computer interface and the resulting responses to the various upsell's are stored to optimize the system for future up selling opportunities.

Appellant expresses no opinion on the accuracy of the Examiner's characterization of the Katz reference. However, the Examiner's characterization of the Katz reference is wholly



unrelated to the language of the limitations recited in claim 23. Therefore, even if the Examiner's characterization is accurate, Katz still cannot anticipate claim 23.

In sum, neither the final Action nor the Examiner's answer has established the factual evidence necessary to establish a *prima facie* case of anticipation of claim 23. Furthermore, Katz fails to disclose or suggest elements of claim 23, and therefore cannot anticipate claim 23. Therefore, the rejection of claim nine under 35 U.S.C. §102(b) must be reversed.

Claim 26 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 26.

## II. Rejections Under 35 U.S.C. §103

Claims 24 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Katz. Appellant traverses this rejection, and asserts that the final Action fails to establish a *prima facie* case of obviousness.

### A. Legal Standard for Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations. (See, *MPEP 2143*). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As with anticipation, the Examiner bears the burden of proof to provide a factual basis to support a rejection under 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the appellant.

### B. Claims 24 and 27

Neither the final Action nor the Examiner's Answer establish a *prima facie* case that renders obvious claim 24. Further, there remains *no evidence of record whatsoever* to support the assertion in the final Action that claims 24 is obvious.

The final Action acknowledged that Katz fails to disclose associating a product identifier with one or more promotional codes, as recited in claim 24. The Action asserted that it would have been obvious to modify the method taught by Katz with the use of promotional codes “since it was known in the art that promotions are identified by codes to provide a way of tracking the promotions.” However, the Action failed to cite any references to support the assertion of obviousness or to assert Official Notice. Appellant traversed the rejection, and invited the Examiner to point out with specificity. The Examiner’s Answer maintains the rejection and still fails to cite any reference to support the rejection or to assert Official Notice.

In sum, there is no evidence of record to support the assertion. Therefore, the rejection is improper and must be withdrawn. (See MPEP 2144.03).

In the Examiner’s Response section of the Examiner’s Answer, the Examiner asserts that teaches the future of providing promotional items such as coupons associated with the primary transaction, “[the upsell is an] offer of a good or service, or to a coupon, ticket, card or other promotional material having a variable or designated value for the purchase, lease or other acquisition in the future of a good or service” and it is well known in the art to use a code such as a barcode as an identifier. It would have been obvious to a skilled artisan in the marketing art to include code as a tracking feature to ensure proper matching and verification during redemption of the promotion. Again, Appellant expresses no opinion on the accuracy of the Examiner’s characterization of the Katz reference. However, the Examiner’s characterization of the Katz reference is wholly unrelated to the language of the limitations recited in claim 24. Therefore, even if the Examiner’s characterization is accurate, Katz still cannot render obvious claim 24.

In sum, neither the final Action nor the Examiner’s answer has established the factual evidence necessary to establish a *prima facie* case of obviousness of claim 24. Furthermore,

Katz fails to disclose or suggest elements of claim 24, and therefore cannot render obvious claim 24. Therefore, the rejection of claim nine under 35 U.S.C. 103(a) must be reversed.

Claim 27 recites corresponding limitations. Hence, the aforementioned arguments apply to claim 27.

### CONCLUSIONS

The Examiner's Answer fails to provide an evidentiary record sufficient to support an anticipation rejection of claims 9-23, 25, 26 and 28 under 35 U.S.C. §102. Therefore, Appellant urges the Board to reverse the examiner's rejections under 35 U.S.C. §102 of claims 9-23, 25, 26 and 28.

Further, the Examiner's Answer fails to provide an evidentiary record sufficient to support an obviousness rejection of claims 24 and 27 under 35 U.S.C. §103. Therefore, Appellant urges the Board to reverse the examiner's rejections under 35 U.S.C. §103 of claims 24 and 27.

Respectfully submitted,

Jed W. Caven  
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Attorney for Appellants

A handwritten signature in black ink, appearing to read 'Jed W. Caven', with a stylized, cursive script.

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Date: July 8, 2007